



Administrative Notice Guidelines

Procedures for Relying on Facts Which
are Not of Record as Common
Knowledge or for Taking Official Notice

Anton Fetting
Legal Advisor
Office of Patent Legal Administration



Administrative Notice Defined

- [The PTO] may take notice of facts beyond the record which, while not generally notorious, are capable of such instant and unquestionable demonstration as to defy dispute
 - Assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art
 - *In re Ahlert*, 424 F.2d 1088, 165 USPQ 418 (CCPA 1970)



Proper Use of Administrative Notice

- Role of administratively noticed facts in the evidentiary scheme
 - Supplement or clarify the teaching of a reference disclosure
 - Justify or explain a particular inference drawn from the reference
 - Serve to "fill in the gaps" which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection.
- Should not comprise the principal evidence upon which a rejection is based
 - *In re Ahlert*, 424 F.2d 1088, 165 USPQ 418 (CCPA 1970), *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1639 (Fed. Cir. 2001)



Considerations For Taking Administrative Notice

- When it is appropriate to take official notice of facts without supporting documentary evidence
- When it is appropriate to rely on common knowledge in the art in making a rejection
- What evidence is necessary to support the examiner's conclusion of common knowledge in the art



Procedure for Taking Administrative Notice

- Determine when it is appropriate to take official notice without documentary evidence to support a conclusion
- If official notice is taken of a fact, unsupported by documentary evidence, the technical line of reasoning underlying the decision must be clear and unmistakable
- If applicant challenges a factual assertion as not properly officially noticed or not properly based upon common knowledge, the **examiner must support the finding with adequate evidence**
- Determine whether the next Office action should be made final.



When Taking Administrative Notice, Record Must Present

- Substantial Evidence Supporting Conclusions
- Explanation for Conclusions Drawn
- Explicitly Set Forth Basis for Facts Administratively Noticed



Substantial Evidence Required

- Expertise may provide sufficient support for conclusions only as to peripheral issues.
- Cannot simply reach conclusions based on own understanding or experience -- or on an assessment of what would be basic knowledge or common sense.
- Rather, must point to some concrete evidence in the record in support of these findings.
 - *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1639 (Fed. Cir. 2001)



Explanation for Conclusions Required

- Opinion must explicate its factual conclusions, enabling [the court] to verify readily whether those conclusions are indeed supported by 'substantial evidence' contained within the record.
 - *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1360, 56 USPQ2d 1351, 1356 (Fed. Cir. 2000)



Explicitly Set Forth Basis Required

- When examiners rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed in the record.
- Cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.
 - *In re Lee*, 61 USPQ2d 1430 (CAFC 2002)



Criteria for Using Administrative Notice

- Official notice unsupported by documentary evidence should only be taken by the examiner
 - where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known
 - In appropriate circumstances, it might not be unreasonable to take official notice of the fact that it is common sense to make something faster, or cheaper, or better, or stronger without the support of documentary evidence.
 - It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well-known are not capable of instant and unquestionable demonstration as being well-known.

When Not to Take Administrative Notice

- Officially noticed facts should not be the principal evidence upon which a rejection was based.
 - Official notice without documentary evidence to support an examiner's conclusion is permissible only in very limited circumstances.
 - It is never appropriate to rely solely on "basic knowledge" in the art or "common sense," without evidentiary support in the record, as the basis for core factual findings underlying a patentability rejection.
 - Findings of "basic knowledge" or "common sense" in the art may only be used to support peripheral issues.

Implications of Taking Administrative Notice

- If official notice is taken of a fact, unsupported by documentary evidence,
 - the reasoning underlying a decision to take such notice should be clear and unmistakable.
- If applicant challenges a factual assertion as not properly officially noticed or not common knowledge
 - the examiner must support the finding with adequate evidence.

After Administrative Notice Is Taken (Traversal)

- To traverse administrative notice
 - Applicant must specifically point out the supposed errors in the examiner's action
 - Why the noticed fact is not considered to be common knowledge or well-known in the art.
 - General allegation that the claims define a patentable invention is inadequate.

After Administrative Notice Is Taken (Response to Traverse)

- If applicant adequately traverses, the examiner must
 - Provide documentary evidence in the next Office action if the rejection is to be maintained.
 - If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding.



After Administrative Notice Is Taken (Not Traversed)

- If applicant does not traverse or applicant's traverse is not adequate
 - Examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate.
 - Examiner should include an explanation as to why it was inadequate.



Can Next Action Be Final?

- If the examiner adds a reference in the next Office action after applicant's rebuttal,
 - and the newly cited reference is added only as directly corresponding evidence to support the prior common knowledge statement, and
 - it does not result in a new issue or constitute a new ground of rejection,
 - the Office action may be made final.
- If no amendments are made to the claims,
 - the examiner must not rely on any other teachings in the reference if the rejection is made final.
- If the newly cited reference is added
 - for reasons other than to support the prior common knowledge statement and
 - a new ground of rejection is introduced by the examiner that is not necessitated by applicant's amendment of the claims,
 - the rejection may not be made final.



Summary

- Any rejection relying in part on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion
 - should be rare
 - should be of notorious character
 - should serve only to "fill in the gaps" which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection.



Further Information

- For further details on Office policy regarding Administrative Notice, see MPEP 2144.03